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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,194	11/13/2000	Casey William Norman	1391-CIP-00	6427
35811 7590 07/03/2012 IP GROUP OF DLA PIPER LLP (US) ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103				
EXAMINER				
ROSS, DANA				
ART UNIT		PAPER NUMBER		
3725				
NOTIFICATION DATE		DELIVERY MODE		
07/03/2012		ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CASEY WILLIAM NORMAN
and TORQUIL PATRICK NORMAN

Appeal 2009-011653
Application 09/711,194
Technology Center 3700

Before LINDA E. HORNER, STEVEN D.A. McCARTHY,
and KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Casey William Norman and Torquil Patrick Norman (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1, 3-16, 18, 20, and 21. Claims 2, 17, and 19 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A seamless doll's skin comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which repeatedly covers and is removed from the doll and transforms the doll into a different character or object, has a wall thickness from 1 to 3mm, has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

O'Brian	US 2,944,368	July 12, 1960
Washburn	US 4,063,402	Dec. 20, 1977
Wion	US 4,294,036	Oct. 13, 1981
Kramer	US 5,607,339	Mar. 4, 1997
Gross	US 5,913,708	June 22, 1999
Yasuda	US 5,928,803	July 27, 1999
Norman	US 09/844,322	filed Apr. 26, 2001

MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (10th ed.) (definition of "resilient")

The following Examiner's rejections are before us for review:

1. Claims 1, 4-7, 13-16, 18, 20, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being

unpatentable over claims 20, 21, 28, 29, 31, 33-36, 38, 39, 41, 42, and 44 of Application No. 09/844,322;

2. Claims 1, 6-8, 10, 13-16, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Washburn;

3. Claims 3-5 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Yasuda;

4. Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Fogarty; and

5. Claims 1 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda, Kramer, and O'Brian.

OPINION

The provisional obviousness-type double patenting rejection

Appellants do not contest the merits of the Examiner's provisional rejection. App. Br. 22-23. Rather, Appellants "request that further treatment of this rejection be held in abeyance pending resolution of the other aspects of their appeal." *Id.* at 23. We decline to decide the appeal as to this provisional rejection in light of the fact that a Notice of Abandonment (mailed July 30, 2009) has issued for Application No. 09/844,322. We leave it to the Examiner to determine whether the rejection should be maintained in light of that notice of abandonment.

The O'Brian/Kramer Obviousness Rejections

The Examiner rejected claims 1, 6-8, 10, 13-16, 20, and 21 as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Washburn. O'Brian discloses a toy doll designed to be an improvement on the paper doll concept. O'Brian, col. 1, ll. 15-16. O'Brian's doll is three-dimensional, with apparel that is curved so as to snap onto the doll body. *Id.*, col. 2, l. 52 – col. 3, l. 11; figs. 1-5. Each article of apparel is “formed out of a single piece of resilient material ... [and] is temporarily deformed and snapped” onto the doll. *Id.*, col. 4, ll. 57-66 (claim 1). When snapped into place, the articles are held against the doll so that they cannot move. *Id.*, col. 3, ll. 12-18. O'Brian's preferred material is polyethylene because “it possesses a comparatively high amount of rigidity when curved as described, and yet is capable of sufficient deformation so as to achieve the essential action required for this invention.” *Id.*, col. 4, ll. 36-43. Kramer discloses a bath toy that is a doll formed from a flexible sheet of polymer plastic material. Kramer, col. 1, ll. 4-5, 51-56.

Appellants argue that “one of ordinary skill in the art would have utterly no incentive or motivation to combine O'Brian with Kramer.” App. Br. 10, *see also id.* at 11. Appellants assert that “[O'Brian's] ‘snapping’ action is a totally different mechanism to achieve positioning of the clothing relative to the doll or a doll-like shape as compared to Kramer, which relies on surface tension supplied by the presence of water.” *Id.* at 10. The Examiner reasoned that it would have been obvious to modify O'Brian's garment according to Kramer's teachings “to provide more flexibility.” Ans. 5.

The Examiner's reason for modifying O'Brian lacks a rational basis. The Examiner has not adequately explained why a person of ordinary skill would desire to make O'Brian's garments more flexible. O'Brian's invention relies on the relative rigidity of the material to allow the garments to snap onto the doll body and to be retained thereon. It is not reasonable to conclude that one would consider using a flexible material such as Kramer's in garments that require rigidity. In this rejection, the Examiner does not rely on Gross, Wion, or Washburn in any manner which cures the deficiency in the reasoning to combine O'Brian and Kramer. *See* Ans. 6. As such, we do not sustain the rejection of claims 1, 6-8, 10, 13-16, 20, and 21 as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Washburn.

Similarly, in rejecting claims 3-5, 11, and 12, the Examiner does not articulate any adequate reason why it would have been obvious to further modify O'Brian in light of Yasuda or Fogarty so as to cure the deficiency in the underlying combination of O'Brian and Kramer. *See* Ans. 7. Thus, we do not sustain the rejection of claims 3-5 and 11 as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Yasuda, or the rejection of claim 12 as being unpatentable over O'Brian, Kramer, and either Gross or Wion and further in view of Fogarty.

The rejection of claims 1 and 9 as being unpatentable over Yasuda, Kramer, and O'Brian

Independent claim 1 recites, in part, an injection molded material. Appellants present arguments pertaining to this aspect of the claim. *See* App. Br. 18. The Examiner's articulation of the Yasuda/Kramer/O'Brian rejection lacks any finding or discussion of the *injection* molded language of

claim 1. *See* Ans. 7-8. The Examiner's limited response to Appellants' arguments made in the Appeal Brief regarding the same do not address the injection molded language persuasively. *See* Ans. 11. As such, we are constrained to reverse the rejection of claim 1, and of its dependent claim 9, as being obvious over Yasuda, Kramer, and O'Brian.

DECISION

The decision of the Examiner to reject claims 1, 3-16, 18, 20, and 21 is reversed.

REVERSED

Klh